

REMARKS

Claims 1-5, 7-10, 15, and 17-20 were pending in this application.

Claims 1-5, 7-10, 15, and 17-20 have been rejected.

Claims 1-5, 7-10, 15, and 17-19 have been amended as shown above.

Claims 21-26 have been added.

Claims 1-5, 7-10, 15, and 17-26 are now pending in this application.

Reconsideration and full allowance of Claims 1-5, 7-10, 15, and 17-26 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 2, 4, 5, 7-9, 15, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,991,737 to Chen (“*Chen*”) in view of U.S. Patent No. 5,819,034 to Joseph et al. (“*Joseph*”). The Office Action rejects Claims 3 and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Chen* and *Joseph* in further view of U.S. Patent No. 5,991,601 to Anderson (“*Anderson*”). The Office Action rejects Claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Chen*, *Joseph*, and *Anderson* in further view of U.S. Patent No. 5,949,492 to Mankovitz (“*Mankovitz*”). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (*Fed. Cir.* 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re*

Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

Chen recites a mechanism to enable automated purchasing of products, such as recordings of songs played on the radio. (Col. 1, Lines 4-11). A consumer may identify a radio station through which the consumer has learned of a song. (Col. 3, Lines 28-43). Using the identity of the radio

station, a remote processing station allows the consumer to order the product. (*Col. 3, Lines 47-64*).

Chen simply recites that a consumer may choose to purchase recordings of songs played on the radio. *Chen* lacks any mention of receiving and rendering a song multiple times. More specifically, *Chen* lacks any mention of receiving and rendering a song a limited number of times before purchase and additional times after purchase.

Because of this, *Chen* fails to disclose, teach, or suggest receiving and rendering “content material” a “limited number of times” prior to communicating a “purchase request” and rendering the content material “additional times” after an “authorization” is “received in response to the purchase request” as recited in Claims 1, 7, and 15. *Joseph* is not cited by the Office Action as disclosing, teaching, or suggesting these elements of Claims 1, 7, and 15. As a result, the proposed *Chen-Joseph* combination fails to disclose, teach, or suggest all elements of Claims 1, 7, and 15.

For these reasons, the proposed *Chen-Joseph* combination fails to disclose, teach, or suggests the Applicants’ invention as recited in Claims 1, 7, and 15 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1-5, 7-10, 15, and 17-20.

II. NEW CLAIMS

The Applicants have added new Claims 21-26. The Applicants respectfully submit that no new matter has been added. The Applicants respectfully request entry and full allowance of Claims 21-26.

III. CONCLUSION

The Applicants respectfully assert that all pending claims in the application are in condition for allowance and respectfully request an early allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Applicants have included the appropriate fee to cover the cost of a request for continued examination. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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